

11. (twice amended) The method of covering a dental instrument according to claim 10 further comprising performing the screwing motion at a distance of [from] more than 5 [to 10] centimeter above the flame cone; simultaneously moving the dental instrument together with the protective covering along a plane passing through an axis of the protective covering.

REMARKS

Claims 1 and 3 through 16 continue to be in the case.

The Office Action refers to Claim Rejections - 35 USC § 112.

Claims 3-5 stand rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In claim 3, line 5, "a short edge" and two sheets joined sealingly at corresponding edges was not disclosed in the original disclosure and constitutes improper new matter. In claim 11, "5 to 10 centimeter" was

not disclosed in the original disclosure and constitutes improper new matter. The original disclosure states only "5 to 1".

The present amendment changes the language of claims 3 and 11 to overcome the rejection.

The Office Action refers to Claim Rejections - 35 USC § 103.

Claim 1 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Eisner et al (4728290) in view of Stearns (6095811) and Curry ((1742061)). Eisner shows an elastic protective covering 10 made of a thermoshrinkable material, column 9, lines 15-25. The specific tolerance used is an obvious matter of choice in the degree of a known parameter to one of ordinary skill in the art looking to find the best match for the intended instrument. Further the tolerance that the sleeve may make with an inferentially claimed instrument is an obvious matter of choice in the use of the sleeve with an inferentially claimed element. Eisner does not show an elliptical shape. Stearns shows a non-round cross section, see Fig. 2. It would be obvious to one of ordinary skill in the art to modify Eisner to include a non-round shape as shown by Stearns in order to better fit the intended instrument. The specific shape used is an obvious matter of choice in shape to the skilled artisan looking to best match the shape of the intended instrument. Further, the shape before application is a pre step and is not given patentable weight. Eisner shows a tab, or wing, 19 located at the open end to assist in

removing the cover, however, does not show hinged ends. Curry shows two hinged ends 9, 10, see Fig. 5. It would be further obvious to one of ordinary skill in the art to modify the above combination to include two hinged ends as shown by Curry in order to make use of known ways of attaching wings to protective covers in the art.

Applicant respectfully traverses.

The claim 1 of the present application requires a first flat hinged end flap (4). The "proximal pull tab" of the Fife reference hardly could be called "a first flat hinged end flap (4)".

Claims 3-5 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Fife (5480302) in view of Cooper et al () and Curry (1742061). Fife shows a heat shrinkable protective covering 71, column 3, lines 49-51, having a wing, see the "proximal pull tab" in Fig. 10. Fife does not show an end in the shape of a semi-sphere. Cooper shows a rounded end, Fig. 2a. It would be obvious to one of ordinary skill in the art to modify Fife to include a rounded end as shown by Cooper in order to make use of well known shapes for protective covers. The above combination does not show two hinged wings. Curry shows two hinged ends 9, 10, see Fig. 5. It would be further obvious to one of ordinary skill in the art to modify the above combination to include two hinged ends as shown by Curry in order to better cover the instrument. As to claim 3, Fife shows a flattened sheet in Fig. 4.

The process of making is an obvious matter of choice in process steps to the skilled artisan. The specific shape of the cover is an obvious matter of choice in a non-critical shape of a known structure to one of ordinary skill in the art.

Applicant respectfully traverses.

The claim 3 of the present application requires a first wing sheet. The “proximal pull tab” of the Fife reference hardly could be called “a first wing sheet ”.

Claim 3 further requires “an end sheet having more or less the shape of a semi-circle having a first diameter and having an end diameter”.

Figure 1 of the Drawings (Fig.1) of the present application clearly shows a semi-circular shape of the protective covering from the side opposite to the open ends (or inserting hole 3). The Claim 3 of the present application also requires a semi-circle shape of the end sheet of the covering. Neither of the references Fife, Cooper et al., and Curry cited in the Office Action teaches or suggests the “semi-circle” required by claim 3 of the present application.

In addition, claim 4 of the present application requires "an axis defined by the wing sheet and the opposite wing sheet". This feature of claim 4 of the present application is completely absent in the Fife reference.

Furthermore, claim 5 of the present application requires that the removal of the protective covering is made with both the wing sheet and the opposing wing sheet by wrapping. None of the references cited above teaches or suggests these requirements of claim 5.

Claims 6-8 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Fife. Fife shows employing a tubular protective covering 71 having a wing, see the "proximal pull tab" in Fig. 10, placing a dental instrument 112 into the cover and removing by pulling on the tab. To pull the tab in the direction of the body of the cover to remove would be an obvious matter of choice in the direction of pulling to one of ordinary skill in the art looking to remove a covering. The number of wings used is an obvious matter of choice in the number of a known element used to the skilled artisan.

Applicant urges that the Fife reference clearly does not match the steps set forth in claims 6 through 8.

Claim 9 stands rejected under 35 U.S.C. 103(x) as being unpatentable over Fife as applied to claim 6 above, and further in view of Eisner et al. Fife does not show rolling the cover when removing. Eisner teaches turning the

cover inside out when removing by pulling on wing 18, column 9, lines 43-55. It would be obvious to one of ordinary skill in the art to modify Fife to include turning the cover inside out as shown by Eisner in order to protect the user from contamination. To roll the cover is an obvious matter of choice in the manner of turning the cover inside out to one of ordinary skill in the art.

Applicant respectfully disagrees. Applicant where Fife and Eisner agree not to roll the cover, this step is clearly unobvious.

Claims 10 and 11 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Fife (5480302) as applied to claim 8 above and further in view of Holt et al (5070597). Fife teaches heating to shrink fit the cover, however, does not show using a flame. Holt teaches that it is known to heat by use of a flame, column 14, lines 30-33. It would be obvious to one of ordinary skill in the art to modify Fife to include using a flame to heat as shown by Holt in order to make use of known ways of heat shrinking covers. To turn the instrument while heating is an obvious step to one of ordinary skill in the art in order to evenly shrink the cover. As to claim 11, the distance from the flame is an obvious matter of choice in the degree of a known parameter to the skilled artisan wishing to apply the desired heat.

Applicant respectfully traverses. Where Fife and Holt agree not to turn the instrument while heating, this step of turning is clearly unobvious over Fife and Holt.

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Claims 12-16 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Fife (5480302) in view of Holt et al (5070597) as applied to claim 10 above and further in view of Eisner et al (4728290). The above combination does not show cutting a hole for the bur. Eisner teaches cutting a hole for the bur, column 9, lines 15-18. It would be obvious to one of ordinary skill in the art to modify the above combination to include cutting a hole as shown by Eisner in order to be able to use the instrument. As to claim 13, Eisner also teaches using water spray. It would be obvious to also cut a hole for such spray because it is the only logical way to use the shown device. As to claims 15 and 16, Eisner also teaches disinfecting the cover after removal and placing it in a container, column 9, lines 53-60. Placing medical disposal material for burning is well known in the art and would be obvious to the skilled artisan in order to safely dispose of the material.

Fife (5480302), Holt et al (5070597), and Eisner et al (4728290) agree not to burn the resulting medical disposal material. Where three references agree not to provide the step clearly expressed in applicant's claim, this claim is clearly unobvious over the three references.

Applicants submit that the prior art made of record neither anticipates nor renders obvious the present invention.

Reconsideration of all outstanding rejections is respectfully requested.

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All claims as presently submitted are deemed to be in form for allowance and an early notice of allowance is earnestly solicited.

Respectfully submitted,

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